

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-30, all of which have been rejected. By this Amendment, claims 1, 3-4, 7-11, 13-14, 17-21, and 27-30 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 9-10, 19-20, and 29-30 were objected to because of informalities. Claims 11-20 were rejected under 35 USC § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 1-4, 8-14, 18-24 and 28-30 stand

rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,947,768, issued to Adachi, et al. (hereinafter, Adachi), in view of U.S. Patent No. 5,640,678, issued to Ishikawa (hereinafter, Ishikawa). Claims 5-7, 15-17 and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adachi, in View of Ishikawa, and further in view of U.S. Patent Publication No. 2002/0077151, issued to Matthews, et al. (hereinafter, Matthews). The Applicant respectfully traverses these rejections at least based on the following remarks.

#### **I. CLAIM OBJECTIONS**

Claims 9-10, 19-20, and 29-30 were objected to because of informalities. By this Amendment, claims 9-10, 19-20, and 29-30 have been amended, as set forth above, to correct the informalities identified by the Examiner. The Applicant submits that claims 9-10, 19-20, and 29-30 are now allowable.

#### **II. REJECTION UNDER 35 U.S.C. § 101**

The Applicant now turns to the rejection of claims 11-20 under 35 U.S.C. § 101 as being non-statutory because the claimed invention is directed to non-statutory subject matter. The Office Action states the following:

Claims 11-20 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For claim 11, the claim falls within a statutory category and includes a judicial exception but has no practical application. Claims 12-20 are rejected because they depend on claim 11.

See the Office Action at page 2. The Examiner has conceded that Applicant's independent claim 11 falls within a statutory category. However, it appears that the Examiner is only challenging whether Applicant's claim 11 has practical application, i.e., whether Applicant's claim 11 produces useful, tangible and concrete result.

The Applicant respectfully asserts that the disclosed and claimed invention produces useful, tangible and concrete results. The Applicant's invention provides utility that is (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107 and Fisher, 421 F.3d, 76 USPQ2d at 1230. **For example, each of claims 11-20 provides a practical application that produces a useful result, i.e., a machine-readable storage with stored thereon a computer program for facilitating communication in a mesh network using a plurality of access points.** Furthermore, the Applicant's disclosed and claimed invention clearly does not fall in the category of the § 101 Judicial exceptions. Accordingly, there is no need for the Applicant to distinguish the disclosed and/or claimed subject matter from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application.

With regard to tangible results, the Applicant respectfully asserts that the disclosed and claimed invention recites more than a § 101 judicial exception and that

the claims specifically set forth a practical application to produce a real-world result, such as, for example, facilitating communication in a mesh network using a plurality of access points.

With regard to concrete results, since appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, in instances where the invention cannot operate as intended without undue experimentation. Since no such rejection was received, the Applicant assumes that the invention provides useful results. Notwithstanding, the Applicant respectfully asserts that the disclosed and claimed invention provides useful results and the results are repeatable and predictable.

**The Applicant points out that the preamble of independent claim 1 specifically recites the utility of Applicant's claims, i.e., for facilitating communication in a mesh network using a plurality of access points. At least for the above reasons, the Applicant believes that claims 11-20 comprise patentable subject matter and are believed to be allowable. The Examiner has stated that claims 11-20 have "no practical application". The Applicant respectfully disagrees. For example, claim 11 recites that at least one of a plurality of access devices is serviced by a second access point located in a second cell, whenever a signal for the access devices falls below a specified threshold, which is a useful, concrete and tangible result.**

Accordingly, the Applicant courteously requests that the rejection under 35 USC § 101 be withdrawn and each of claims 11-20 be allowed. The Applicant reserves the right to argue additional reasons beyond those set forth above that support the allowability of all rejected claims.

### III. REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the

suggestion....," citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

#### **A. Rejection of Claim 1**

Claims 1-4, 8-14, 18-24 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adachi, in view of Ishikawa. With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Adachi and Ishikawa does not disclose or suggest at least the limitation of "servicing within the mesh network, said at least one of a plurality of access devices by said at least a second access point located in said second cell, whenever a signal for said at least one of a plurality of access devices falls below a specified threshold," as recited by the Applicant in independent claim 1.

Initially, the Applicant points out that **neither Adachi nor Ishikawa disclose a mesh network or processing within a mesh network**. In addition, the Examiner concedes the following in the Office Action:

Adachi teaches all of the subject matter of the claimed invention except servicing the at least one of a plurality of access devices by the at least a second access point located in the second cell whenever a signal for the

at least one of a plurality of access devices falls below the specified threshold.

See the Office Action at page 4. The Examiner then states the following:

Ishikawa from the same or similar fields of endeavor teaches servicing the at least one of a plurality of access devices by the at least a second access point located in the second cell whenever a signal for the at least one of a plurality of access devices falls below a specified threshold (see column 7 lines 1-59).

See the Office Action at page 5. Ishikawa discloses, at the above citation, how handover processing is performed in instances when a mobile station moves from one macrocell zone to another. **Ishikawa does not disclose or suggest any servicing of devices within a mesh network, as recited in Applicant's claim 1. For example, the macrocell base stations 1<sub>a</sub>, ..., n<sub>a</sub> of Ishikawa are not part of a mesh network. See Ishikawa at Figure 5 and col. 7, lines 25-59. Furthermore, Ishikawa does not disclose or suggest servicing of a device by an access point, as recited in Applicant's claim 1.**

Therefore, the Applicant maintains that the combination of Adachi and Ishikawa does not disclose or suggest at least the limitation of "servicing within the mesh network, said at least one of a plurality of access devices by said at least a second access point located in said second cell, whenever a signal for said at least one of a plurality of access devices falls below a specified threshold," as recited by the Applicant in independent claim 1. Accordingly, the proposed combination of Adachi and Ishikawa does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable.

Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-4, 8-10, 12-14, 18-20, 22-24, and 28-30**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being anticipated by Adachi in view of Ishikawa has been overcome and request that the rejection be withdrawn. Additionally, claims 2-4 and 8-10, 12-14 and 18-20, and 22-24 and 28-30 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-4, 8-14, 18-24, and 28-30.

**C. Rejection of Dependent Claims 5-7, 15-17, and 25-27**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being anticipated by Adachi in view of Ishikawa has been overcome and request that the rejection be withdrawn. Additionally, since the additional cited reference (Matthews) does not



overcome the deficiencies of Adachi and Ishikawa, claims 5-7, 15-17, and 25-27 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5-7, 15-17, and 25-27.

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-30 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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